

## REMARKS

This Application has been carefully reviewed in light of the Office Action mailed March 17, 2005. At the time of the Office Action, Claims 1-18 were pending in this Application. Claims 19-57 were previously cancelled due to an election/restriction requirement. Claims 1-18 were rejected. Claims 1 and 10 have been amended to further define various features of Applicant's invention. Claims 58-107 have been added. No new matter is presented by these amendments. Applicant respectfully requests reconsideration and favorable action in this case.

### Rejections under 35 U.S.C. § 102

Claims 1-2, 8-11, and 17-18 were rejected by the Examiner under 35 U.S.C. §102(b) as being anticipated by U.S. Patent 4,735,218 issued to Kondo Akiko et al. ("Akiko et al."). Applicant respectfully traverses and submits the cited art does not teach all of the elements of the claimed embodiment of the invention. Specifically, Kondo fails to teach the use of any sort of modified nucleic acid as presently claimed.

Claims 1-2, 8-11, and 17-18 were rejected by the Examiner under 35 U.S.C. §102(b) as being anticipated by Japanese Patent Publication Number 07-241570 filed by Nishi Norio et al. ("Norio et al."). Applicant respectfully traverses and submits the cited art does not teach all of the elements of the claimed embodiment of the invention. Specifically, Norio teaches the combination of nucleic acid and alginic acid, but does not teach any of the currently claimed modifications of nucleic acids.

Claims 1, 4-5, 8-9, 10, 13, and 17-18 were rejected by the Examiner under 35 U.S.C. §102(b) as being anticipated by French Patent Publication No. 2 800 299 filed by Tharaud Cecile et al. ("Cecile et al."). Applicant respectfully traverses and submits the cited art does not teach all of the elements of the claimed embodiment of the invention. The cited portion of Cecile (the

English language abstract) does not teach any modified nucleic acids. Applicants are unable to read French and thus make no representations regarding the remainder of the reference. Applicants do not have an English language translation of Cecile under their control.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1997). Furthermore, "the identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co. Ltd.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Applicant respectfully submits that the cited art as anticipatory by the Examiner cannot anticipate the rejected Claims, because the cited art does not show all the elements of the present Claims.

Accordingly, Applicants assert that no pending claims are anticipated by the cited references and request allowance of Claims 1-18 and 58-107.

#### Rejections under 35 U.S.C. §103

Claims 3 and 12 were rejected under 35 U.S.C. §103(a) as being unpatentable over Akiko et al., Norio et al., and Cecile et al. Applicant respectfully traverses and submits the cited art combinations, even if proper, which Applicant does not concede, does not render the claimed embodiment of the invention obvious.

In order to establish a *prima facie* case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Furthermore, according to § 2143 of the Manual of Patent Examining Procedure, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to

combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

As noted above, Akiko and Cecile do not disclose the modification a nucleic acid at all. Norio merely discloses its combination with alginic acid. Alginic acid is not similar to a crosslinking agent, an alkylating agent, or a cap. Accordingly, Applicants believe that the cited references wholly fail to teach or suggest the invention as presently claims either alone or in combination.

Accordingly, Applicants assert that no pending claims are anticipated by the cited references and request allowance of Claims 1-18 and 58-107.

#### Information Disclosure Statement

Applicant would like to bring to the Examiner's attention that Applicant filed an Information Disclosure Statement on March 16, 2005. Applicant respectfully requests that the Information Disclosure Statements be considered and cited in the examination of the above-referenced application. Applicant attaches a copy of the Information Disclosure Statement and PTO Form 1449 filed March 16, 2005 for the Examiner's convenience and a copy of the postcard receipt evidencing receipt by the Patent Office.

#### **CONCLUSION**

Applicant has now made an earnest effort to place this case in condition for allowance in light of the amendments and remarks set forth above. Applicant respectfully requests reconsideration of the claims as amended.

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The Commissioner is hereby authorized to charge \$25 to Deposit Account No. 50-2148 of Baker Botts L.L.P for adding one defendant claim. The Commissioner is hereby authorized to credit any overpayment or charge any additional fees to Deposit Account No. 50-2148.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicant's attorney at 512.322.2580.

Respectfully submitted,  
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